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EC

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/019,265	11/13/2001	Allen Carl	49386-CIP(71995)	1326

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EXAMINER
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PRIDDY, MICHAEL B

ART UNIT	PAPER NUMBER
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3732

DATE MAILED: 08/01/2003

5

Please find below and/or attached an Office communication concerning this application or proceeding.

EC

# Office Action Summary

Application No.

10/019,265

Applicant(s)

CARL ET AL.

Examiner

Michael B Priddy

Art Unit

3732

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☐ Claim(s) 1 and 73-120 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) 108,111,116-118 and 120 is/are allowed.
- 6) ☐ Claim(s) 1,73,78-83 and 94-100 is/are rejected.
- 7) ☐ Claim(s) 74-77,84-93,101-107,109,110,112-115 and 119 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

## **DETAILED ACTION**

### ***Specification***

The disclosure is objected to because of the following informalities: in line 26 of page 19, "ore" should be ~~or~~.

Appropriate correction is required.

### ***Claim Objections***

Claims 78, 88, 95, 102 and 110 are objected to because of the following informalities: "allow" should be ~~allows~~.

Claims 80, 82, 90, 92, 97, 99, 106, 112 and 114 are objected to because of the following informalities: "collogen" should be ~~collagen~~.

Claims 81, 91 and 113 are objected to because of the following informalities: in line 2, "be" should be ~~being~~.

Claim 98 is objected to because of the following informality: in line 3, "be" should be ~~being~~.

Claims 82, 92 and 114 are objected to because of the following informalities: in line ~~from~~ should be inserted between "material is made" and "one or more".

Claim 84 is objected to because of the following informalities: in line 7, "for" should be ~~of~~ and in line 13, "fixation member" should be deleted.

Claim 99 is objected to because of the following informalities: in line 2, ~~of~~ or ~~from~~ should be inserted between "made" and "one".

Art Unit: 3732

Claim 100 is objected to because of the following informalities: in line 7, "an arcuate fixation member" should be deleted.

Claim 101 is objected to because of the following informalities: in line 1, "spinal" should be deleted and in line 15, "an arcuate fixation member." should be deleted.

Claim 109 is objected to because of the following informalities: in lines 1-2, "said step of forming includes forming an arcuate aperture in each of the adjacent vertebrae" should be --said aperture in each of the adjacent vertebrae is arcuate--.

Claim 115 is objected to because of the following informalities: in line 2, "an aperture in each of the adjacent vertebrae" should be deleted.

Claim 119 is objected to because of the following informalities: in line 3, "(i.e., non-through aperture)" should be --aperture--.

Appropriate correction of these minor informalities is required.

### ***Claim Rejections - 35 USC § 112***

Claims 76 and 94-100 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

A) Claim 76 recites the limitation "the preformed aperture" in line 1. There is insufficient antecedent basis for this limitation in the claim. For examination purposes, 76 will be treated as depending from 75.

Art Unit: 3732

B) Claims 94 and 100 recite the limitation "the portion passing through the intravertebral prosthesis" in lines 5-6. There is insufficient antecedent basis for this limitation in the claims.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 73, 78-83 and 94-100 are rejected under 35 U.S.C. 102(b) as being anticipated by Steffee (U.S. 4,790,303). Steffee teaches a method for securing an intravertebral prosthetic device 24, comprising implanting a solid arcuate fixation member 70/50/52 between the vertebrae and passing a portion of the arcuate fixation member through the intravertebral prosthetic device, wherein a portion 70 of the fixation member is made from a flexible material disposed between end sections 50 & 52, each end section 50 & 52 being made of a non-flexible material conducive to attachment to the vertebrae. Wherein the non-flexible material is metal and the flexible material is a composition. The method of implantation is set forth in column 3.

Art Unit: 3732

***Allowable Subject Matter***

Claims 74-77 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claims 84-93, 101-107, 109, 110, 112-115 and 119 would be allowable if rewritten or amended to overcome the objection(s) set forth in this Office action.

Claims 108, 111, 116-118 and 120 are allowed.

***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Green et al. teaches a device having structure similar to that of the arcuate fixation member claimed by Applicant. Kuslich teaches a spinal fixation device including a rod (fixation member) and an intravertebral implant. Ulrich teaches use of an arcuate member to pin fractured vertebra.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael B. Priddy whose telephone number is (703) 308-8620. The examiner can normally be reached on Mon.-Fri. 8 a.m. - 5 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kevin Shaver can be reached on (703) 308-2582. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9302 for regular communications and (703) 872-9303 for After Final communications.

Art Unit: 3732

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1148.

Michael B. Priddy

*Michael B. Priddy*  
July 30, 2003